



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,887	04/16/2001	Paola Lenti	1011-287	4551

7590 10/12/2004

James V. Costigan, Esq.
HEDMAN & COSTIGAN, P.C.
Suite 2003
1185 Avenue of the Americas
New York, NY 10036-2646

EXAMINER

PIERCE, JEREMY R

ART UNIT	PAPER NUMBER
----------	--------------

1771

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/835,887

Applicant(s)

LENTI, PAOLA

Examiner

Jeremy R. Pierce

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-28 is/are pending in the application.
- 4a) Of the above claim(s) 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-26 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on July 26, 2004 has been entered. Claims 20-23 have been cancelled, rendering the previous 35 USC 112 and 103 rejections set forth in the last Office Action moot. New claims 24-28 have been added.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 24-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 24 and 28 recite "said top layer having a top layer top surface comprising a woven or a non-woven material having smear resistant properties." Use of "top layer having a top layer top surface" is confusing. Why is the phrase "top layer" used twice?

Claims 24 and 28 recite "said central layer having a bottom face coupled to a bottom face coupled to a bottom layer of a fabric material." This is also confusing and indefinite.

Claim 26 recites the top surface is a "woven and died wool felt." This should be changed to "woven and dyed wool felt."

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bender et al. (U.S. Patent No. 4,263,727) in view of Latzke (U.S. Patent No. 4,887,368) and Dessaint et al. (U.S. Patent No. 4,295,976), and further in view of Cohen (U.S. Patent No. 4,187,621).

Bender et al. disclose a web of natural or synthetic fibers that is flame-laminated to closed-cell polyolefin foam (column 1, lines 31-35) without the use of adhesive (column 2, lines 31-33). In a preferred embodiment, closed-cell polyethylene foam is combined with an upper layer of woven cotton fabric and a lower layer of nonwoven nylon (column 2, lines 62-68). The nonwoven nylon fabric layer in the laminate would be suitable for attachment to a male coupling portion of a tearable strip means because nonwoven fabric is capable of coupling to male portions of tearable strip means.

Although Bender et al. disclose the top layer can be a woven cotton fabric (column 2, line 65), the reference does not disclose it to be a woven wool fabric that is dyed and smear resistant. Latzke discloses that woven wool, as well as woven cotton can be used as a skin compatible layer in a shoe insole (column 7, lines 42-46). It would have been obvious to one having ordinary skill in the art to use woven wool as the top layer in the insole of Bender et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. It would also have been obvious to dye the wool fabric any desired color for use as a shoe insole. Neither Latzke nor

Art Unit: 1771

Bender et al. disclose a smear resistant property in the upper layer. Dessaint et al. disclose that a stain resistant property may be imparted onto textile fabrics, including woven and nonwoven articles of cotton and wool (column 7, lines 36-45). It would have been obvious to one having ordinary skill in the art to add a stain-resistant agent to the top layer of Bender et al. in order to improve likelihood of avoiding stains, as taught by Dessaint et al.

Although Bender et al. does not disclose the top layer to have projecting and recessed patterns, Latzke shows that the insole material is preferably made with recessed areas to better accommodate a foot (see Figures 15 and 16). It would have been obvious to a person having ordinary skill in the art at the time of the invention to provide the insole of Bender et al. with recessed areas in order to make the insole more comfortable for the wearer. Bender et al. do not disclose that the shoe insole is die cut with a contour mold. Cohen teaches an insole for shoes where the layers are flame-bonded together and then cut and conformed in contour with various thickness (Claim 1), so Cohen also recognizes the importance of molding with recessed areas and projected areas. It would have been obvious to one having ordinary skill in the art to use the method of forming a shoe insole disclosed by Cohen in the insole of Bender et al. in order to create a shoe insole that better fits the wearer's foot.

Response to Arguments

6. Applicant's arguments filed July 26, 2004 have been fully considered but they are not persuasive.

7. Applicant argues that the new limitation reciting the laminate is "die-cut and hot pressed to provide said top face of said central layer and said top layer surface of said top layer with surface projections and recessed patterns" is not disclosed by the prior art references. However, this new limitation is reciting processing steps. Claim 24 is a product claim, so the processing limitations are given weight only to the extent that they materially change the product. Although Bender does not teach the concept of die-cutting and hot pressing the top layer and middle layer to form projecting and recessed patterns, the product limitations are still met because Latzke teaches providing such a feature to an insole material, as set forth above. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

8. Applicant argues that Latzke could not be combined with the teachings of Bender, but Applicant does not provide reasoning that conflicts with the Examiner's reasoning for combining the references. Latzke teaches recessed and projecting portions. Applicant has not claimed any particular pattern for what the projecting and recessed portions must be, so the claim limitation is met so long as there is some three-dimensional structure to the laminate.

9. Applicant argues that one in the art of floor and wall coverings would not be directed to the insole art, which is not analogous. However, the recited claim limitations with regards to the top, central, and top layers are met by the prior art references. The

Art Unit: 1771

use of the laminate as a wall covering is the recitation of an intended use. The recitation of a wall covering has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

10. Additionally, the newly claimed feature of die-cutting and providing surface projections and recessed patterns was also addressed in the last Office Action using the teachings from the Cohen reference. Applicant has not addressed any supposed deficiencies in the combination of the prior art with Cohen in the response.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 1771

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

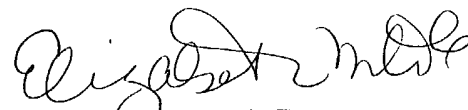
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (571) 272-1479. The examiner can normally be reached on Monday-Thursday 7-4:30 and alternate Fridays 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JRP

JRP
October 6, 2004


ELIZABETH M. COLE
PRIMARY EXAMINER